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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,606	10/29/2003	Gregory Wolff	015358-005210US	9621

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EXAMINER
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NGUYEN, HAI V

ART UNIT	PAPER NUMBER
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2142

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/697,606

Applicant(s)

WOLFF, GREGORY

Examiner

Hai V. Nguyen

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 12-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 October 2003 and 18 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/19/2004.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to the application filed on 29 October 2003.
2. This instant application is a division of patent # 6,668,271 B1.
3. Claims 1-11 are presented for examination.

#### ***Specification***

4. The textual portion of the specification is replete with grammatical and idiomatic errors too numerous to mention specifically. The specification should be revised carefully.
5. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks <sup>TM</sup>, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

#### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

Art Unit: 2142

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 12-24 are rejected on the ground of nonstatutory double patenting over claims 1-11 of U. S. Patent No. 6,668,271 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

**In the instant application:**

**Claim 24:** A method of processing information for use on a network, comprising:

- configuring a plurality of agency base units such that each agency based unit is addressable at an address on the network;
- coupling each of the plurality of agency base units to an HTTP server;
- storing, on an agent card of a plurality of agent cards, at least one response functionality for implementing one or more document request response function;
- storing, in an XML file in a file system on the agent card, state for the at least one response functionality that is provided to a user of the network at an address dependent

Art Unit: 2142

on the address of the agency base unit into which the agent card is mounted, wherein a response functionality implements one or more functions of responding to document requests.

**In the patent #: 6,668,271 B1:**

**Claim 11:** A networked of information appliance for use on a network, comprising:

a plurality of agency base units, wherein each agency based unit is configured on the network with an address and is coupled to an HTTP server; and

a plurality of agent cards, wherein each agent card includes storage for state, stored as an XML file in an agent card file system, for at least one response functionality that is provided to a user of the network at an address dependent on the address of the agency base unit into which the agent card is mounted, wherein a response functionality implements one or more functions of responding to document requests and wherein that state included on each agent card is a state of the response functionality.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 12-24 are rejected under 35 U.S.C. 102(e) as being anticipated by **Edwards et al. US patent # 6,562,076 B2**.

10. As to claim 12, Edward substantially teaches the invention as claimed, including a method of processing information for use on a network, comprising:

configuring a plurality of agency base units (*Fig. 3, base units 20a-20n*) such that each agency unit is addressable at an address on the network (*Fig. 3, DMS NFS server; col. 3, lines 57-63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28*);

storing, on an agent card of a plurality of agent cards (*Fig. 3, repositories 14a-14n*), at least one response functionality implementing one or more document response functions (*active property attached to the document*) (*Fig. 3, col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42*);

storing, on the agent card, state for the at least one response functionality that is provided to a user (*Fig. 3, a principal*) of the network at an address dependent on the

Art Unit: 2142

address of the agency base unit into which the agent card is mounted, wherein the state included on the agent card is a state of the at least one response functionality (*Fig. 3, col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28*).

11. As to claim 13, The method of claim 1, mounting the agent card to the agency base unit (*Fig. 3, col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28*); and triggering the at least one response functionality by a document request issued to the agency base unit over the network (*Fig. 3, col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35*).

12. As to claim 14, further comprising coupling the plurality of agency base units are coupled to an agency device (*Fig. 3, DMS NFS server; col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35*).

13. As to claim 15, further comprising coupling the plurality of agency base units are coupled to an HTTP server (*Fig. 4; DMS NFS server; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35*).

14. As to claim 16, further comprising storing the state as an XML file in a file system on the agent card (*col. 3, lines 40-45*).

15. As to claim 17, further comprising storing transformations of documents as described by a tagset are stored as a tagset file in a file system on the agent card (*Fig.*

Art Unit: 2142

3, *MS NFS server*; col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35).

16. As to claim 18, further comprising adapting the agent card with program instructions for applying transforms specified in a tagset to a document (*Fig. 3, MS NFS server*; col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35).

17. As to claim 19, further comprising storing state, tagsets and data in a file structure (*Fig. 3, MS NFS server*; col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35).

18. As to claim 20, further comprising storing state, tagsets and data in a static file structure (*Fig. 3, MS NFS server*; col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35).

19. As to claim 21, further comprising adapting the agent card to perform on-card processing for processing messages received from an agency through a message passing interface (*Fig. 3, MS NFS server*; col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35).

20. As to claim 22, further comprising processing, on the agent card, messages received from an agency through a message passing interface (*Fig. 3, MS NFS server*;



Art Unit: 2142

*col. 3, lines 57-63; col. 10, line 61 – col. 11, line 63; col. 13, lines 1-42; Fig. 4; col. 13, line 44 – col. 14, line 28; col. 14, line 49 – col. 15, line 35).*

21. As to claim 23, further comprising:

monitoring for an ejection request indicating a desire to eject the agent card (*col. 15, lines 10-58*); and in response to receipt of the ejection request, writing a state of the agent card to the agent card prior to the agent card being removed from the agency base unit (*col. 15, lines 10-58*).

22. Claim 24 introduces similar limitations of claim 1, 16; therefore, it is rejected under the same rationale as in claims 1, 16.

23. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

Art Unit: 2142

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai V. Nguyen  
Examiner  
Art Unit 2142



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